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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,827	09/26/2001	Bruce A. Sullenger	180/124/2	1175

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EXAMINER

MCGARRY, SEAN

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/963,827	SULLENGER ET AL.	
	Examiner	Art Unit	
	Sean R McGarry	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-67 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 2, drawn to an RNA aptamer binding prothrombin, classified in class 536, subclass 24.5.
- II. Claims 2, 10, 15, 15, and 17, drawn to an RNA aptamer binding thrombin, classified in class 536, subclass 24.5.
- III. Claim 2, drawn to an RNA aptamer binding IX, classified in class 536, subclass 24.5.
- IV. Claims 2, 3, 4, 5, 13, drawn to an RNA aptamer binding IXa, classified in class 536, subclass 24.5.
- V. Claims 2, 13, drawn to an RNA aptamer binding X, classified in class 536, subclass 24.5.
- VI. Claims 2, 8, 9, 19 drawn to an RNA aptamer binding Xa, classified in class 536, subclass 24.5.
- VII. Claim 2, drawn to an RNA aptamer binding VII, classified in class 536, subclass 24.5.
- VIII. Claims 2, 6, 7, 18, 13, drawn to an RNA aptamer binding VIIa, classified in class 536, subclass 24.5.
- IX. Claims 21-26, drawn to a method of modulating the biological activity of a coagulation pathway factor via an RNA aptamer, classified in class 514, subclass 44.

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- X. Claims 31, 32, drawn to an RNA aptamer binding E2F, classified in class 536, subclass 24.5.
- XI. Claims 33-35, drawn to a method of modulating E2F via an RNA aptamer, classified in class 514, subclass 44.
- XII. Claims 36-45, drawn to a method of identifying a ligand to a target from a candidate mix thereof, classified in class 435, subclass 4.
- XIII. Claim 46, drawn to a ligand, classified in class 530, subclass 300.
- XIV. Claims 47-55, drawn to a method to identify a ligand selective for a target, classified in class 435, subclass 4.
- XV. Claim 56, drawn to a product identified by a method, classified in class 530, subclass 350.
- XVI. Claims 57-60, 61, 64, drawn to an RNA aptamer binding Ang1, classified in class 536, subclass 24.5.
- XVII. Claims 57-60, 62, 63, 64, drawn to an RNA aptamer binding Ang2, classified in class 536, subclass 24.5.
- XVIII. Claims 65-67, drawn to a method of modulating Ang1 activity via an RNA aptamer, classified in class 514, subclass 44.
- XIX. Claims 65-67, drawn to a method of modulating Ang2 activity via an RNA aptamer, classified in class 514, subclass 44.

Claim 20 is generic to Groups I-VIII and the examination of claim 20 will be limited to that subject matter elected.

Claim 1 link(s) inventions I-VIII. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VIII, X, XVI, and XVII are all unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are all RNA aptamer targeted to different gene product targets. Each RNA aptamer target has different biological activities and acts at various points along any given biological pathway and an aptamer targeting one target could not be used to target another target, for example.

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Each RNA aptamer has a different structure that targets a specific target structure, for example.

Inventions (I-VIII, X, XVI, XVII) and (IX, XIXIX, XVIII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the RNA aptamers could be used in a materially different method such as in situ localization assay, for example.

Inventions XII and XIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different methods that use different method steps, which utilize different components where the different steps of the different methods using different components lead to different results, for example.

Inventions XIII and XV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different compound where one is an undefined "ligand" and the other is an undefined "product".

Inventions (XII and XIV) and (IX, XI, XVIII, and XIX) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together

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and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the different inventions are different methods that are mutually exclusive. One set of methods is drawn to a method of modulating a specified target while the other set of methods is drawn to method to identify specified products or ligand, for example.

Inventions (XIII and XV) and (I-VIII, X, XVI, and XVII) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the invention of one set is drawn to RNA aptamers for modulating specified targets while the other set is drawn to undefined "ligand" and "products", for example.

Inventions (XII and XIV) and (I-VIII, X, XVI, and XVII) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are mutually exclusive in that the methods of XIV and XII are drawn to method of identifying ligands and products and are not drawn to RNA aptamers, which is what the other groups are drawn to, for example.

Each group that contains claimed sequences is **further restricted** (not a species requirement) as follows:

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the RNA aptamer sequences listed in the claims are subject to restriction. The Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, *up to* 10 independent and distinct nucleotide sequences will be examined in a single application. (see MPEP 803.04 and 2434). In this case 1 sequence has been deemed a reasonable number of sequences to be searched. Applicant must elect a sequence that belongs/corresponds to the numbered group elected above.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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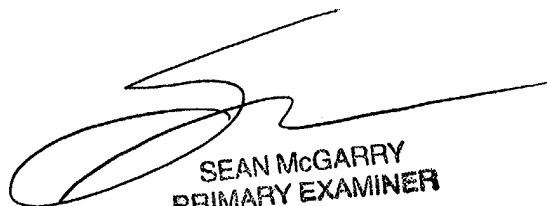
remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean R McGarry whose telephone number is (703)305-7028. The examiner can normally be reached on M-Th (6:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SRM


SEAN MCGARRY
PRIMARY EXAMINER
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